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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,494	12/22/2000	Robert C. Hankinson	93-00-001 (014208.1385)	8279

7590 12/09/2004

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT PAPER NUMBER

3623

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,494

Applicant(s)

HANKINSON, ROBERT C.

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15 and 17-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - a. Page 3, line 6, "efficiently" is grammatically incorrect.
 - b. Page 6, lines 9-11, and page 14, line 17, please describe Figures 2A and 2B separately. It is suggested that "Figure 2" be changed to --Figures 2A and 2B--.
 - c. Page 7, line 17, "perform" is grammatically incorrect.
 - d. Page 12, line 29, "monitor" should be --reviewer--.
 - e. Page 19, line 6, "45" should be --44--; lines 8, 13, and 17, "246" should be --248--; line 14, "248" should be --250--. (See Figure 2A)
 - f. Page 20, line 9, "44a" should be --48a--.
 - g. Page 21, line 7, "48" should be --48c--; line 13, "40" should be --30--.
 - h. Page 22, first paragraph, for consistency "114" should be --114a-- when referring to successor project owner and --114b-- when referring to predecessor project owner.
 - i. Page 22, line 11, "database 44" should be --database 40--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1, 4-15, and 18-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the LeRouge article "Managing by Projects" in view of the Atkinson et al. article "A Stakeholder Approach to Strategic Performance Measurement."

Regarding claims 1, 15, 29, 34, and 36, LeRouge discloses a method and system for implementing a project in an organization comprising several phases: an initiation phase, a planning phase, an execution and controlling phase, and a closing phase. LeRouge discloses that the management-by-project method and system have certain capabilities. The method and system include receiving and storing data in a database insofar as there is a discussion of tools to store and retrieve project information and a discussion of database alteration (project software tools to store and retrieve project information, e.g., p.71, c.1; database alteration, e.g., p.72, c.1-2; sentence spanning p.73-74). The method and system include monitoring and reports, for example, determination whether the project is progressing in accordance with timelines and costs, for example (monitoring and alert capabilities, e.g., p.71, c.3; p.72, c.1; p.73, c.3). The use of timelines is the same as a schedule. Further, the method and system include corrective action (real-time adjustments, e.g., p.71, c.1; profit planning and accountability, e.g., p.70, c.3)) and modifying the database in response to a corrective action (database alteration, e.g., p.72, c.1-2; sentence spanning p.73-74). Although LeRouge does not explicitly teach the use of a corrective action request, LeRouge does discuss the need for and advantage of "real-time adjustments" (p.71, c.1) to a project. Adjustments of this type are a form of corrective action. LeRouge discloses the use of database alteration, therefore, it would have been inherent in the LeRouge management-by-project system that at least one database would be used to store and retrieve information about each project.

LeRouge does not explicitly disclose the use of a contract to represent the agreement between the organization and project owner (project manager), however, LeRouge does discuss to the use of contract management (e.g., p.73, c.3), detailed employee and project information to determine resource allocation across projects and the use of project software tools to store and retrieve project information (p.71, c.1). Le Rouge also discloses management of a project schedule (timeline, on-time performance, e.g., p.70, c.1; p.76, c.2); and templates (work breakdown templates, e.g., p.71, c.3) for various project components. Generally, templates are used to generate information that is complete and consistent. How the information is used in LeRouge is what classifies it as a contract between the project owner (project manager) and the organization (management).

Atkinson et al. disclose the use of an employment contract (performance measurement) to test and manage the relationship between the employee and the organization. Performance measurement includes monitoring and reporting performance in terms of implementation of organization plans (p. 30 c. 1, p. 31, c.1). It is inherent in contractual relationships that the contract parameters are stored in a file, whether the file is a computer database or a paper file. It is well known that the success of contractual relationships is determined by comparison of a party's performance to the contract terms. It is also inherent in contractual relationships that a breach or failure to comply with contract terms gives rise to penalizing the breaching or non-complying party. The examiner takes official notice that the extent of the penalty against a non-complying party may be part of the contract terms and may result in contracting with a different party.

It would have been obvious to modify LeRouge as taught by Atkinson et al. to include a contract or agreement between the project owner (project manager) and the organization in order to reinforce the importance of performance and to measure the employee performance against the objectives of a particular project. In the method and system of LeRouge as modified by Atkinson, the work breakdown template sets forth the schedule and budget that the project manager will meet throughout the project, i.e., a type of contract. The claim limitation that the contract is "made by" the project owner (project manager) is not a patentable distinction over the LeRouge-Atkinson insofar as the project owner (project manager) provides input during the planning phase and/or updates the information during the execution phase of the project.

Regarding claims 4-8 and 18-22, Le Rouge discloses the step of displaying information that is relevant to a project owner's responsibilities (accessibility, e.g., p.70, c.3). The information is accessible by employees who would be reviewing the progress of the project including executives. And LeRouge discloses the use of templates (work breakdown templates, e.g., p.71, c.3) for various project components.

Regarding claims 9, 23, 31, and 32, LeRouge discloses the step of associating the project with a budget and schedule (on-time and on-budget performance, e.g., p.70, c.1; p.76, c.2).

Regarding claims 10, 24, and 30, LeRouge discloses an association with a benefit realization plan (profit planning, e.g., p.70, c.3).

Regarding claims 11, 25, and 35, LeRouge discloses modification of an agreement and saving the modifications on the database (change-order updates, e.g., p.73, c.3).

Regarding claims 12 and 26, LeRouge discloses that the management by project method and system may be integrated with payroll (p.76, c.3, 1.18-29). LeRouge is silent as to the

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particular enforcement division for project owner penalties. The examiner takes official notice that it is the responsibility of an organization's payroll department to compensate employees through salary and benefits. Moreover, the payroll department disperses compensation as determined by the organization. It would have been obvious to one of ordinary skill in the art to modify the method and system of LeRouge and Atkinson et al., to include enforcement of a penalty to the project owner (project manager) by the payroll department as deemed appropriate by the executive staff within the payroll integration in order to ensure that an employee's salary is adjusted in accordance with executive staff directives.

Regarding claims 13, 27, and 37, LeRouge discloses project termination upon completion of the project (closing phase, e.g., p.72, c.1).

Regarding claims 14, 28, and 33, LeRouge discloses the use of a project owner (project manager) for a particular project. It is inherent that if a project owner leaves an organization, is promoted, or is assigned to other duties, then a successor project owner would step in and the database would reflect the change.

3. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeRouge and Atkinson et al. as applied to claims 1 and 15, respectively, above, and further in view of the Theofanos et al. article "Digital Signatures: Signing and Notarizing Electronic Forms."

LeRouge as modified by Atkinson et al. does not disclose the use of electronic signatures when a project owner accepts the organization's project contract or agreement.

Theofanos et al. disclose the benefit of using electronic signatures with electronic business records. The use of electronic signatures in place of a handwritten signature increases the trustworthiness and protects the authenticity and security of the electronic business records.

It would have been obvious to one of ordinary skill in the art to modify the method and system of LeRouge to include the use of electronic signatures for the contract or agreement between the organization and project owner, as taught by Theofanos et al., in order to increase the trustworthiness and to protect the authenticity and security of the contract or agreement between the organization and the project owner for every project.

Response to Amendment

4. Applicant's arguments filed 19 October 2004 have been fully considered but they are not persuasive.

a. In response to applicant's argument that LeRouge fails to disclose, teach, or suggest that the project manager enter into a contract to take responsibility for implementing a project according to a schedule, the examiner acknowledges that LeRouge does not meet all of the limitations of claim 1. However, it is the combined teachings of the references as a whole that meet claim 1. Namely, LeRouge discloses a contract management method and system for a project including terms of resources, budget, and schedule; and, Atkinson teaches a contract between an organization and its employee(s). It would have been obvious to combine the references as detailed in the obviousness rejection above.

b. In response to applicant's argument that Atkinson makes no mention of a contract specifying an agreement made by the project owner to take responsibility for implementing a project according to a schedule, or a contract generated from a contract template, the examiner acknowledges that Atkinson alone does not meet all of the limitations of claim 1. However, it is the combined teachings of the references as a whole that meet claim 1. Namely, LeRouge discloses a contract management method

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and system for a project including terms of resources, budget, and schedule; and, Atkinson teaches a contract between an organization and its employee(s). It would have been obvious to combine the references as detailed in the obviousness rejection above.

c. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, LeRouge discloses a software application to manage contracts. Atkinson teaches a contract between an organization and an employee of the organization. The suggestion to combine the references is found in the knowledge generally available to one of ordinary skill in the art, as discussed above in more detail, and that such a person would have found it obvious to use the software application of LeRouge to manage any type of contract. Atkinson, as a whole, teaches an agreement between an organization and a project manager employed by the organization. Applicant cites a portion of the Atkinson reference that mentions implied contracts. First, the discussion of implicit contracts is in the context that for organizations that rely on employee skill and motivation, the traditional methods may be replaced by implicit contracts. Further, the portion of Atkinson cited by applicant is under the heading "Implicit and Explicit Contracts" and the article also mentions that the stakeholder's

[employee's] performance is monitored and measured. These teachings combined with the LeRouge software application, would have rendered the claims obvious to one of ordinary skill in the art at the time of the invention by applicant. Second, the possible benefits of an implied contract mentioned in the Atkinson reference does not teach away from the LeRouge-Atkinson combination because not only does the Atkinson reference mention the use of explicit contracts it teaches a method and system for implementing a project governed by an agreement between a project owner [stakeholder or employee] and an organization. The LeRouge and Atkinson references, as a whole, teach the use of a software application to monitor a contract, which is representative of an agreement, between an organization and a project manager. The teachings of Atkinson are to show that a contract between an employee and an organization were known at the time of applicant's invention.

d. In response to applicant's argument that there is no suggestion to combine because implicit contracts cannot be managed by a software tool, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, the LeRouge system of a software tool to monitor contract performance combined with the Atkinson's teaching to form a contract between an employee and an organization would have made obvious to one of ordinary skill in the art

of project implementation a system for implementing a project comprising a processing manager operable to receive a contract specifying an agreement between an organization and project owner, as discussed above.

e. In response to applicant's argument that implied contracts cannot be managed by software, there are known means to ensure compliance with contract terms, whether the contract is implied or explicit. For example, an implicit employment contract between an employee and an organization may be that an employee will perform the duties necessary to accomplish organization objectives and the organization will compensate the employee. Not every organization will reduce such an implicit expectation to writing, however, the organization keeps records of objectives (and compensation) and an employee is likely to keep records of initiatives that were implemented to accomplish those objectives. Thus, the use of software to manage a contract is not directly tied to the type of contract (implied vs. explicit) and applicant's argument that implicit contracts cannot be managed by software is not persuasive.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918. The examiner can normally be reached on Mon - Thu and alternate Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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